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JERRY.SHORMA@HP.COM
ipa.mail@hp.com
laura.m.clark@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY D. KNITTER

Appeal 2009-007457
Application 10/635,815
Technology Center 2400

Before THOMAS S. HAHN, ELENI MANTIS MERCADER, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

HAHN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellant invokes our review under 35 U.S.C. § 134(a) from rejections of claims 1-22. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF CASE²

*Exemplary Claims*³

According to Appellant, the claimed method, computer program product, and client server call for receiving a method call from a client computer to invoke an object on a data server. The method call is packaged in a message sent from the client server to the data server. The object on the client computer that is invoking the object on the data server is identified from an execution stack by using an algorithm. Dependent claims further recite that the message comprises a Simple Object Access Protocol (SOAP).⁴

Claims 1 and 6 are illustrative:

1. A method of identifying a message source in a network, comprising:

receiving a method call from a client computer to invoke an object on a data server;

packaging the method call in a message to be sent from a client server to the data server via the network;

² Appellant identified Application Serial No. 10/448,646, which is incorporated by reference in this application (Spec. ¶ [0001]), as including appealed claim rejections (Br. 2). A Decision (Appeal No. 2008-4867) for that appeal was mailed on May 15, 2009, and the application was indicated to be abandoned on July 21, 2009.

³ Throughout this opinion we refer for their respective details to the Specification filed Aug. 7, 2003, the Final Action mailed Sep. 26, 2007, the Appeal Brief filed Apr. 17, 2008, and the Examiner's Answer mailed May 14, 2008.

⁴ See generally Spec. ¶¶ [0013]-[0015]; Figs. 1, 2.

on the client server, identifying, from an execution stack and through the use of a comparison algorithm, an object on the client computer that is invoking the object on the data server; and transmitting the message to the data server.

6. The method of claim 1, wherein the message comprises a simple object access protocol (SOAP) message.

Rejections

Claims 1-22 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement (Ans. 3-8).

Claims 6-9, 15-18, and 21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite (Ans. 8-9).

The Examiner or Appellant has cited the following documents:

Mein US 6,457,066 B1 Sep. 24, 2002

Apache Software Foundation, Web Services - Axis,
<http://ws.apache.org/axis/> (last visited Jan. 25, 2011).

Corba Fundamentals Glossary, <http://www.ooportal.com/corba-fundamentals/corba-fundamentals-glossary.php> (last visited Jan. 25, 2011).

Posting of Jim White to
<http://groups.google.com/group/comp.lang.java.programmer/msg/b24afb100ccdfe8b> (Apr. 19, 2000).

Dave Winer, Scripting News, <http://scripting.com/2002/09/27.html>, (Sep. 27, 2002).

Appellant's Contentions

Appellant contends, with respect to the lack of enablement rejection under § 112, first paragraph, that “[p]aragraphs [0015]-[0022] and Figs. 2-5 of the present application disclose a method for carrying out the claimed invention” (Br. 5).

The Examiner, under § 112, second paragraph, finds that a claimed SOAP protocol lacks definiteness (*see* Ans. 8-9). Appellant contends that “a precise and clear definition of the SOAP protocol can be obtained from

paragraph [0004] of the specification . . .” and “[t]he protocol described in U.S. Patent No. 6,457,066 . . . and the protocol implemented by Apache Axis were included [in the Specification] as examples of implementations of SOAP” (Br. 7).

Issues

Appellant’s contentions present us with the following issues:

1. Does Appellant’s Specification enable an ordinarily skilled person to practice the invention recited in the claims without undue experimentation?
2. Would an ordinarily skilled artisan understand the scope of the SOAP protocol as recited in claims 6-9, 15-18, and 21?

PRINCIPLES OF LAW

Lack of Enablement

When making an enablement rejection, the Examiner must present a reasonable explanation why “the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement.” *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993).

Enablement is not precluded by the necessity for some experimentation such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. . . .

. . . . The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed.

In re Wands, 858 F.2d 731, 736-37 (Fed. Cir. 1988) (footnotes omitted).

There are eight factors that have been identified as needing to be considered in determining whether a disclosure would require undue experimentation.

See id. at 737.⁵

Lack of Definiteness

The test for definiteness is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986).

What is claimed is determined during patent examination to be the broadest reasonable interpretation of the pending claims that is consistent with the specification. So interpreting the claims requires using the meanings for every claimed term that should be apparent from the prior art or the specification and drawings as filed. Thus, an applicant is required to make clear and precise the terms that are used to define the invention whereby the metes and bounds of the claimed invention can be ascertained. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

⁵ The court listed: “(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.”

ANALYSIS

Lack of Enablement

We agree with the Examiner's conclusion that the Specification does not enable the person having ordinary skill in the art to practice the claimed invention without undue experimentation.

To establish a lack of enablement, the Examiner must present a reasonable explanation why "the scope of protection provided by [the] claim is not adequately enabled by the description of the invention provided in the specification." *Wright*, 999 F.2d at 1562.

As a preface for the provided explanation, the Examiner properly identified that:

The factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue" include, but are not limited to: (a) the breadth of the claims; (b) the nature of the invention; (c) the state of the prior art; (d) the level of one of ordinary skill; (e) the level of predictability in the art; (f) the amount of direction provided by the inventor; (g) the existence of working examples; and (h) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

(Final Action 4-5). The Examiner then proceeded to address each of these factors (*see* Final Action 5-8). The Examiner found the level of predictability in the art suggests that undue experimentation is not required (Final Action 9). In contrast, however, the Examiner found that the breadth of the claims, state of the prior art, and amount of direction provided by the inventor are all factors suggesting that undue experimentation is required (*id.*). As to the other four factors, the Examiner found the evidence of record

insufficient to establish whether or not undue experimentation is required (*id.*). Based on this analysis, the Examiner concluded that “the totality of the evidence suggests that it would require undue experimentation to make and use the claimed invention” (*id.* (emphasis omitted)).

Initially, Appellant responds by generally referencing paragraphs [0015]-[0022] and Figures 2-5 of the application to contend that the application “disclose[s] a method for carrying out the claimed invention” (Br. 5). Appellant acknowledges that “the Examiner sets forth several factors” (*id.*), but Appellant did not address with identified particularity the Examiner’s analyses (*see* Br. 5-7).

Appellant’s arguments appear to arise from the Examiner’s analysis directed to the state of the prior art (Final Action 5); though, Appellant does not explicitly state this relationship (Br. 5-7). In particular, Appellant disagrees with the Examiner’s finding that the Specification inadequately describes “use of a comparison algorithm on a client server to identify an object on the client computer that is invoking the object on [a] data server” (Br. 5 (brackets in original)). What Appellant argues is that paragraph [0019] describes how a comparison algorithm on a client server is used to identify an object on the client computer that is invoking the object on a data server by disclosing that “[t]he identifier (fully qualified class name) of the source of the SOAP call is stored in a SOAP header which is part of the message transmitted from the client computer 11 to the data server 140 (via client server 120)” (Br. 6 (brackets in original)).

In responding to Appellant, the Examiner finds:

First . . . paragraph [[0019]] omits *where* this header is inserted, and appears to be merely a summation of what is occurring on the *client server*. In other words, this paragraph

describes that the *client server* determines the class name (by means unknown) and forwards it to the data server to be reviewed by an administrator. This interpretation is consistent with the rest of the specification, most notably paragraph [0015]. In contrast, Appellant's argument that this paragraph describes the *client computer* sending a portion of its execution stack is *not* consistent with the rest of the specification.

Second . . . information in the header, regardless of which device sends it, only describes a *class*, not an *object* as required by the claims. There is absolutely no mention in the specification of using an algorithm to identify an object from a class name.

Third, if this header already contains the class name, it is unclear why the client server would need a "comparison algorithm" to identify it. There is absolutely no mention in the specification of using a comparison algorithm to analyze a message header.

(Ans. 10). We agree with these Examiner findings. In light of these findings and the absence of any challenge from Appellant, we find Appellant's arguments unavailing and we agree with the Examiner's rejection under 35 U.S.C. § 112, first paragraph, of claims 1-22.

Lack of Definiteness

We agree with the Examiner's rejection under 35 U.S.C. § 112, second paragraph, of claims 6-9, 15-18, and 21 as being indefinite for failing to particularly point out and distinctly claim the subject matter, i.e., "SOAP," that Appellant regards as the invention.

To establish a lack of definiteness, the Examiner must present a reasonable explanation why those skilled in the art would not understand what is claimed when the claim is read in light of the Specification.

Orthokinetics, 806 F.2d at 1576.

The Examiner explains that the rejected claims recite a SOAP, and also that the Specification incorporates by reference Mein and Apache Axis ([¶¶ 0003]-[0004]) where SOAP is alternatively described (Final Action 10). Specifically, the Examiner finds:

The protocol described in [Mein] is for accessing Microsoft COM Automation objects using MIME-encoded messages (see col. 3, lines 1-64), while the protocol that is implemented by Apache Axis is for accessing W3C SOAP web services using XML messages (see “Introduction” on the Axis home page). The protocols are similar in that they are layered on top of HTTP and are used to access remote objects, but are otherwise entirely different.

(*Id.*).

Appellant does not contest that different SOAP protocols are described, but variously responds that:

[A] precise and clear definition of the SOAP protocol can be obtained from paragraph [0004] of the specification which describes briefly how the SOAP protocol operates.

....

The protocol described in [Mein] and the protocol implemented by Apache Axis were included as examples of implementations of SOAP. In other words, these implementations are only subsets of a larger SOAP class that is compatible with the applicant’s invention. . . . [C]laims 6-9, 15-18, and 21 do not refer only to [Mein’s] SOAP implementation or to the Apache Axis SOAP implementation, but the claims refer to any implementation that a person having ordinary skill in the art would recognize as a SOAP implementation.

(Br. 7-8).

The Examiner responds that “Appellant appears to be seeking protection on any protocol which happens to be named ‘SOAP’ or ‘Simple Object Access Protocol’” (Ans. 12). In particular, “the Examiner . . .

submits that no reasonably precise definition of SOAP exists which encompasses both the protocol described in [Mein] and the protocol implemented by Apache Axis. The protocols are vaguely related in that they are used to access remote objects, but are wholly and fundamentally different in operation” (*id.*). We agree with these Examiner findings. The Examiner, we accordingly find, has presented a reasonable explanation why those skilled in the art would not understand what is claimed when the claim is read in light of the Specification. In light of these findings and the absence of any challenge from Appellant, we agree with the Examiner’s rejection under 35 U.S.C. § 112, second paragraph.

CONCLUSIONS

1. The Examiner has not erred in finding Appellant’s Specification lacks adequate enablement for an ordinarily skilled artisan to practice the invention recited in the claims without undue experimentation.
2. The 35 U.S.C. § 112, first paragraph, rejection of claims 1-22 is sustained.
3. The Examiner has not erred in finding the scope of the SOAP protocol as recited in the claims lacks definiteness.
4. The 35 U.S.C. § 112, second paragraph, rejection of claims 6-9, 15-18, and 21 is sustained.

ORDER

The Examiner’s rejections of claims 1-22 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2010).

Appeal 2009-007457
Application 10/635,815

AFFIRMED

babc

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
3404 E. Harmony Road
Mail Stop 35
FORT COLLINS CO 80528